

REMARKS

Claims 1-20, 22-37, and 39-49 are pending, with claims 1, 25, 39, and 47 being independent. Claims 1, 19, 20, 25, 39, and 47 have been amended and claim 49 has been added. Support for the amendments and the new claim can be found in the originally-filed specification, at least at page 5, lines 8-15 and lines 24-28; page 6, line 22 to page 7, line 21; page 8, line 28 to page 9, line 31; and Figs. 5, 6A, 7A, 7B, 8, 9A-9G, 11A, and 11B. No new matter has been introduced.

Claim Rejections – 35 U.S.C. §102

Claims 39, 41-43, 45, and 46 have been rejected as being anticipated by U.S. Patent No. 3,199,248 (Suzuki). Applicant requests withdrawal of this rejection because Suzuki fails to describe or suggest a body and an appendage that at least partly directly contact a horizontal supporting surface, where the appendage at least partly supports the body and also includes a first end that rotates relative to the body about an axis, as recited in independent claim 39.

In Suzuki's toy, a tail 11 couples to a connecting rod 6, which couples to a rotatable crank 3. See Suzuki at col. 2, lines 36-67 and Figs. 2 and 3. However, Suzuki's beak part 9 (which also couples to the rotatable crank 3) does not at least partly contact a horizontal supporting surface nor does Suzuki's beak part 9 at least partly support a body 1 of the toy, and the body 1 does not partly contact a horizontal supporting surface. Rather, Suzuki's beak part 9 is positioned at a head 9 that is supported on top of Suzuki's body 1, and the body 1 is supported by talons (not labeled) that attached to a tree limb (not labeled). See Suzuki at col. 2, lines 36-65 and Figs. 2 and 3.

Accordingly, claim 39 is allowable over Suzuki, as are dependent claims 41-43, 45, and 46.

Claim Rejections – 35 U.S.C. §103

Claims 1-5, 7-20, and 48 have been rejected as being unpatentable over U.S. Patent No. 6,672,934 (Hornsby) and Suzuki. Applicant requests withdrawal of this rejection because

neither Hornsby, Suzuki, nor any proper combination of the two describes or suggests a body at least partly directly contacting a horizontal supporting surface and an appendage having a body portion coupled to a body of the toy and a support portion that at least partly directly contacts a horizontal supporting surface to at least partly support the body, where the appendage is actuated to move including movement of the support portion along a non-circular path, as recited in independent claim 1.

Hornsby relates to a lizard portion 10 having a body portion 12 to which a tail portion 16 and a head portion 14 are attached. See Hornsby at col. 2, line 64 to col. 3, line 2 and Fig. 1. The body portion 12 is supported on a horizontal surface by sets of legs 18, 20. See Hornsby at col. 3, lines 2-4 and Fig. 1. Additionally, Hornsby's head portion 14 includes a tongue 44 that can protrude from a mouth of the head portion 14. See Hornsby at col. 3, lines 60-64 and Fig. 8.

The Examiner appears to equate the body portion 12 with the recited body and the tongue 44 with the recited appendage. However, while the tongue 44 may protrude from the mouth of the head, the tongue 44 does not include a support portion that at least partly contacts the horizontal supporting surface to at least partly support the body portion 12. Additionally, although the legs 18, 20 have ends that at least partly contact the horizontal supporting surface, Hornsby never describes or suggests that the ends of the legs 18, 20 are actuated to move along a non-circular path. Moreover, the body portion 12 does not at least partly directly contact the horizontal supporting surface; rather, it is the legs 18, 20 in Hornsby's lizard portion 10 that directly contact the horizontal supporting surface.

Suzuki does not remedy the failure of Hornsby to describe or suggest this subject matter. In Suzuki, the only appendage that is coupled to the body 1 and that also has an end that at least partly contacts a horizontal supporting surface is the talon at the base of the body 1. However, Suzuki's talon does not move along any path nor does Suzuki's body 1 at least partly directly contact the tree limb.

Thus, any proper combination of Hornsby and Suzuki would still fail to describe or suggest the subject matter of claim 1. Accordingly, claim 1 is allowable over Hornsby and Suzuki, as are dependent claims 2-5, 7-20, and 48.

Claim 6 has been rejected as being unpatentable over Hornsby, Suzuki, and U.S. Patent No. 5,876,273 (DeCesare). Claim 6 depends from claim 1, which was rejected as being unpatentable over Hornsby and Suzuki. As discussed above, neither Hornsby, Suzuki, nor any proper combination of the two describes or suggests an appendage having a body portion coupled to a body of the toy and a support portion that at least partly contacts a horizontal supporting surface to at least partly support the body, where the appendage is actuated to move including movement of the support portion along a non-circular path, as recited in independent claim 1. Moreover, DeCesare does not remedy the failure of the references to describe or suggest this subject matter. In DeCesare, a toy 10 is provided with a body 12 and a head 11 including a movable tongue 46. See DeCesare at col. 5, lines 13-47 and Figs. 1 and 2. The body 12 is supported by legs and paws that contact a horizontal supporting surface (unlabeled). However, DeCesare does not describe or suggest that any part of the legs or paws would be actuated to move or to move along a non-circular path.

Accordingly, claim 1 is allowable over Hornsby, Suzuki, and DeCesare, and claim 6 is allowable for at least the reasons that claim 1 is allowable.

Claims 22-24 have been rejected as being unpatentable over Hornsby and U.S. Patent No. 1,782,477 (Price). Claims 22-24 depend from claim 1, which was rejected as being unpatentable over Hornsby and Suzuki. As discussed above, neither Hornsby, Suzuki, nor any proper combination of the two describes or suggests a body at least partly directly contacting a horizontal supporting surface and an appendage having a body portion coupled to a body of the toy and a support portion that at least partly contacts a horizontal supporting surface to at least partly support the body, where the appendage is actuated to move including movement of the support portion along a non-circular path, as recited in independent claim 1. Moreover, Price does not remedy the failure of the references to describe or suggest this subject matter. In Price, an animated toy is provided with a body, a head, and legs. See Price at Figs. 2 and 3. The body is entirely supported by the legs, which contact a horizontal supporting surface (unlabeled). However, Price does not describe or suggest that any part of the body would be directly contacting the horizontal supporting surface.

Accordingly, claim 1 is allowable over Hornsby, Suzuki, and Price, and claims 22-24 are allowable for at least the reasons that claim 1 is allowable.

Claims 25-37 have been rejected as being unpatentable over U.S. Patent No. 4,878,875 (Pin-Hung) and Suzuki. Applicant requests withdrawal of this rejection because neither Pin-Hung, Suzuki, nor any proper combination of the two describes or suggests actuation of an appendage to move relative to a body at least partly contacting a horizontal supporting surface without advancing the body along the horizontal supporting surface, as recited in claim 25. Moreover, as discussed previously, Pin-Hung also fails to describe or suggest at least a tail device coupled to the body of a toy and actuated by a motor to move relative to the body, and one of ordinary skill in the art would not have been motivated to modify Pin-Hung with the teachings of Suzuki in the manner suggested in the Office Action.

Pin-Hung relates to a climbing toy in the shape of a monkey. See Pin-Hung at abstract and Fig. 1. The toy includes a motor 11 fixed to the side of a base 43, and a limb climbing mechanism 8 that is actuated by the motor 11. See Pin-Hung at col. 2, lines 10-29 and Figs. 6 and 7. The limb climbing mechanism 8 includes a convex pad 90, 91 at an end of a spring 88, 89 attached to a connecting bar 84, 85. See Pin-Hung at col. 3, line 64 to col. 4, line 23 and Figs. 6 and 7. The connecting bar 84, 85 is mounted with a pin 86, 86 to an end of a y-shaped lever 80, 81, which is engaged with a cam wheel 30, 31 that is actuated by the motor 11. See Pin-Hung at col. 3, lines 9-22; col. 3, line 65 to col. 4, line 9; and Figs. 6 and 7. Additionally, the toy includes a board 34 that is moved up and down by a pushing bar 32 that is coupled to the motor 11. See Pin-Hung at col. 3, lines 8-22 and Figs. 2 and 11.

However, Pin-Hung's base 43 is not on a horizontal supporting surface such that actuation of the limb climbing mechanism 8 relative to the base 43 occurs without advancing the base 43 along a surface. Rather, Pin-Hung's base 43 is positioned along a vertical supporting surface such that actuation of the mechanism 8 advances the base 43 relative to the supporting surface to cause Pin-Hung's toy to climb. Suzuki does not remedy the failure of Pin-Hung to describe or suggest this subject matter. The body 1 of Suzuki's toy parrot does not at least partly

contact any horizontal supporting surface. Rather, Suzuki's toy parrot includes talons that are attached to a tree limb and that extend from the body 1. See Suzuki at Fig. 1.

Additionally, as discussed previously, Pin-Hung does not describe or suggest a tail device that is also actuated by the motor 11 to move relative to the base 43 either along a second path or about an axis. Realizing this deficiency, the Examiner cites Suzuki. However, modification of Pin-Hung to include the tail of Suzuki would change the principle of operation and make Pin-Hung's toy inoperable for its intended purpose. Motivation to modify cannot be found where such modification would change the principle of operation or make the invention inoperable. See MPEP §§2143.01 V. and VI.

Thus, for at least these reasons, claim 25 is allowable over any proper combination of Pin-Hung and Suzuki, as are dependent claims 26-37.

Claim 44 has been rejected as being unpatentable over Suzuki. Claim 44 indirectly depends from independent claim 39, which was rejected as being anticipated by Suzuki. As discussed above, Suzuki fails to describe or suggest a body and an appendage that at least partly directly contact a horizontal supporting surface, where the appendage at least partly supports the body and also includes a first end that rotates relative to the body about an axis, as recited in independent claim 39. In Suzuki's toy, the beak part 9 (which also couples to the rotatable crank 3) does not at least partly contact a horizontal supporting surface nor does Suzuki's beak part 9 at least partly support a body 1 of the toy, and the body 1 does not partly contact a horizontal supporting surface. Rather, Suzuki's beak part 9 is positioned at a head 9 that is supported on top of Suzuki's body 1, and the body 1 is supported by talons (not labeled) that attached to a tree limb (not labeled). See Suzuki at col. 2, lines 36-65 and Figs. 2 and 3. Moreover, one of ordinary skill in the art would not have been motivated to modify Suzuki's beak part 9 to at least partly contact a horizontal supporting surface because any such modification would change the principle of operation of Suzuki's beak part 9 (which is to imitate a beak, and does not provide support for the toy body).

Accordingly, for at least these additional reasons, claim 39 is allowable over any proper modification of Suzuki, as is dependent claim 44.

Claim 47 has been rejected as being unpatentable over U.S. Patent No. 3,443,338 (Collins) and U.S. Patent No. 3,164,924 (Iwaya). Applicant requests withdrawal of this rejection because neither Collins, Iwaya, nor any proper combination of the two describes or suggests rotating a body portion of an appendage that is coupled to a body and that includes a support portion that at least partly contacts a horizontal supporting surface including movement of the support portion along a non-circular path without advancing the body along the horizontal supporting surface, as recited in independent claim 47.

Collins relates to a toy dog 5 that is supported on a support surface by paws (unlabeled). See Collins at col. 1, lines 48-50 and Fig. 1. However, Collins never suggests that the paws would include a body portion that is rotated and a support portion that moves along a non-circular path. Rather, the paws are immobile and the body of the toy dog 5 is configured to move up and down. See Collins at col. 1, lines 66-70 and Fig. 1.

Iwaya does not remedy the failure of Collins to describe or suggest this subject matter. In Iwaya, a bird toy 9 includes a body 20 that is mounted to a stay 6. See Iwaya at col. 2, lines 1-25 and Fig. 1. However, Iwaya does not include an appendage that has a body portion coupled to the body and a support portion that at least partly contacts a horizontal supporting surface. Rather, the stay 6 is directly connected to a perch 1, and no appendage is also contacting the perch 1. See Iwaya at Fig. 1.

Thus, any proper combination of Collins and Iwaya would still fail to describe or suggest the combination of features of claim 47. Accordingly, claim 47 is allowable over any proper combination of Collins and Iwaya.

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claim 40 recites allowable subject matter.

New Claims

New claim 49 depends from claim 1, which was rejected as being unpatentable over Hornsby and Suzuki. As discussed above, neither Hornsby, Suzuki, nor any proper combination of the two describes or suggests all of the features of independent claim 1. Accordingly, claim 49 is allowable for at least the reasons that claim 1 is allowable, and for containing allowable subject matter in its own right. In particular, claim 49 recites that a part of the appendage body portion is actuated to move along a circular path to cause the appendage support portion to move along the non-circular path. None of the references describes or suggests such movement.

Conclusion

In conclusion, applicant submits that all claims are in condition for allowance.

The fee in the amount of \$50 for excess dependent claim is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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